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EXAMINER

ROGERS, MARTIN K

ART UNIT

PAPER NUMBER

1747

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,561	<b>Applicant(s)</b> MARCHINI ET AL.	
	<b>Examiner</b> MARTIN ROGERS	<b>Art Unit</b> 1747	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 48-94 is/are pending in the application.
- 4a) Of the above claim(s) 50,53,54,66,67 and 70-94 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48,49,51,52,55-65,68 and 69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/10/2010, 7/19/2010, 11/17/2009, 5/16/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 50, 53, 54, 66, 67, and 70-94 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected method for manufacturing a tire and apparatus for manufacturing a tire, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/18/2010.

Applicant's election with traverse of claims 48, 49, 51, 52, 55-65, 68, and 69 in the reply filed on 10/18/2010 is acknowledged. The traversal is on the ground(s) that the fact that Ogawa shows that the subject matter of claim 70 is old in the art does not indicate that there is lack of unity of invention among the claims, that the examiner did not follow the proper criteria for restriction under MPEP 803, and there is no serious burden to examine all of the claims together. This is not found persuasive because as the Election/Restriction stated, the entire subject matter of claim 70 is old in the art. Because the subject matter of the entire claim is old in the art, there cannot possibly be a shared special technical feature. Because the *claims of the application* lack unity of invention, Applicant is required to elect a single group corresponding to a single invention. Applicant further states that there is no search burden to search the claims of Groups I and II together and that M.P.E.P. 803 states that such a burden must exist in order for the restriction requirement to be proper. At the outset, the examiner notes that there is a search burden due to the separate classification and divergent fields of search

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for the two groups. However, such discussion is moot because the section of the M.P.E.P. which applicant cited is directed towards applications filed under 35 USC 111. The present application is filed under 35 USC 371 and is therefore subject to different restriction criteria. Furthermore, as noted the special technical feature shared by the groups is known, the basis of any patentability for each group would be different – i.e., there is a burden to separately determine the patentability of each group.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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2. Claims 48, 49, 51, 52, 55-58, 61, 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caretta et al. (EP 0976534) in view of Scarzello et al. (WO 01/62480), Holroyd et al. (USP 5201975), and Roy et al. (USP 4382757).

In regards to claim 48, Caretta discloses a process for manufacturing a tire (Abstract) in which an elastomeric layer is provided on the outer surface of a toroidal support, the shape of the toroidal support's surface matching the shape of the inner surface of the tire ([0045-0046]). A tire is assembled on the elastomeric layer ([0046]) and introduced into a molding cavity with walls that match the desired shape of the outer surface of the tire ([0013]) such that a working fluid presses the inner surface of the green tire by being admitted to a gap between the tire and toroidal support ([0013]). Before admitting the working fluid to the gap, the elastomer needs to be cured by applying heat ([0079]). Caretta does not utilize a toroidal support with internal protruding elements.

However, Caretta discloses that the use of electric resistors to heat the toroidal support is merely exemplary and further suggests to one of ordinary skill in the art that any well known method of heating the surface of the toroidal support would be suitable for the invention. Scarzello discloses that one of ordinary skill would appreciate that the use of steam is well known for heating a toroidal support (Page 9, line 34 through Page 10, line 4). Additionally, Holroyd discloses that one of ordinary skill would appreciate that electrical heating and steam heating are functionally equivalent for providing curing heat to a tire curing surface (Column 2, lines 42-43). Therefore, one of ordinary skill in

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the art would have found it obvious to use steam to heat the toroidal support of Caretta during the elastomer precuring operation because this is a well known heating method suitable for performing this heating step (as disclosed by Scarzello and Holroyd) and additionally because it is functionally equivalent to using electric heating (as disclosed by Holroyd). The examiner notes that although Scarzello lists the interior surface of the support to be labeled 14 in the cited paragraph, this is a clerical error. The interior surface of the toroidal support (which is in contact with the steam) is supposed to have been labeled 15, as evidenced by Page 9, lines 20-25 of Scarzello.

Roy discloses that when using steam to heat the exterior surface of an enclosed space, it is beneficial to provide protruding fins on the interior surface which is in contact with the steam for the benefit of increasing the heat-transfer from the steam (Column 4, lines 50-60). One of ordinary skill would have appreciated that increased heat transfer decreases the required heating time and therefore increases the production efficiency of the process. Therefore, one of ordinary skill in the art at the time of the invention would have found it obvious to provide protrusions on the interior surface of the toroidal support of the above combination of references for the benefit of increasing heat transfer through the toroidal support (as disclosed by Roy).

In regard to claim 49, Roy further discloses that the protrusions be in the form of fins (elongated ribs) (Column 4, line 53).

In regards to claim 51, Roy further discloses that the protrusions extended perpendicularly from the surface of the wall which is in contact with the steam. One applying the teachings of Roy to the toroidal structure of the combination of references would therefore find it obvious to use inwardly protruding ribs.

In regards to claim 52, Roy further discloses that the ribs are obtained in a thickness of the wall material (Figure 8: 79).

In regards to claims 55 and 56, Caretta further suggests to a skilled artisan that any sequence of steps which allows the tire inner liner to be cured before admission of the working fluid to the gap between the tire and toroidal support would be suitable for the invention ([0079]). It is considered well within the ability of one of ordinary skill in the art to determine a suitable time to perform the pre-curing, providing the precuring occurs at some time prior to the final curing the tire.

In regards to claim 57, Caretta further discloses introducing the working fluid into a diffusion gap ([0013]).

In regards to claim 58, Caretta further discloses that the inner surface of the tire is cured by heating the toroidal support to a predetermined temperature ([0047] and [0077]).

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In regards to claim 61 and 63, it is the examiner's position that the pressure used to press on the inner surface of the tire will depend on the size, shape, and composition of the tire as well as the thickness, temperature, and material used for the molding surface. The working conditions of the pressure-applying step would have been optimized by a skilled artisan to achieve a desired result, namely sufficient and uniform curing of the specific tire used within a desired timeframe and at a desired curing temperature.

In regards to claim 64, Caretta further discloses using steam as the primary working fluid ([0082]). It is the examiner's position that a skilled artisan would appreciate that the temperature of the working fluid needs to be adjusted based on the size, composition, and shape of the tire. The working conditions of the heat-applying step would have been optimized by a skilled artisan to achieve a desired result, namely sufficient and uniform curing of the specific tire used within a desired timeframe.

In regards to claim 65, Caretta further discloses the use of steam.

Claims 59, 60, 62 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over the previous combination of Caretta et al. (EP 0976534) in view of Scarzello et al. (WO 01/62480), Holroyd et al. (USP 5201975), and Roy et al. (USP 4382757) as applied to claim 48 above, and further in view of Midgley et al. (USP 1394928).



In regards to claim 59, Caretta does not disclose pressing the tire against the heated toroidal surface with a secondary working fluid.

Midgley discloses curing the interior of a green tire on a heated rigid support (page 2, lines 99-102). Midgley discloses that skilled artisan would consider it to be functionally equivalent to either heat the tire structure in open air or under an applied fluid pressure (Page 2, lines 15-35). Midgley discloses that compressing the carcass against the rigid support during pre-curing has the additional benefit of creating a more uniform product (Page 1, lines 79-84 and 94-101) (Page 2, line 129 though Page 3, line 2). Therefore, one of ordinary skill in the art at the time of the invention would have found it obvious to perform the inner liner pre-curing on the heated supported required by the previous combination during pressing on the exterior surface with a working fluid because this is functionally equivalent to curing in an open air environment (as disclosed by Midgley). One of ordinary skill would have been further motivated to utilize a working fluid to press the tire against the curing surface for the additional benefit of ensuring the uniformity of the product (as disclosed by Midgley).

In regards to claims 60 and 62, it is the examiner's position that the pressure used to press on the outer surface of the tire will depend on the size, shape, and composition of the tire as well as the thickness, temperature, and material used for the rigid support. The working conditions of the pressure-applying step would have been optimized by a skilled artisan to achieve a desired result, namely sufficient and uniform

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curing of the specific tire used within a desired timeframe and at a desired curing temperature.

In regards to claim 68, Midgley further discloses that the pressing occurs simultaneously with the heating (Page 2, lines 15-35).

Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over the previous combination of Caretta et al. (EP 0976534) in view of Scarzello et al. (WO 01/62480), Holroyd et al. (USP 5201975), and Roy et al. (USP 4382757) as applied to claim 48 above, and further in view of Smith et al. (USP 5937517).

In regards to claim 69, Roy does not disclose how the integral fins are created, suggesting to one of ordinary skill in the art that any well known method for creating heat transfer fins would be suitable.

Smith discloses that it is well known in the art to create heat transfer fins by milling (Column 5, line 61). Therefore, one of ordinary skill in the art at the time of the invention would have found it obvious to create the heat transfer fins by milling because this is a well known method of creating integral fins in a material (as disclosed by Smith).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARTIN ROGERS whose telephone number is 571-270-7002. The examiner can normally be reached on Monday through Thursday, 7:30 to 5:00, and every other Friday, 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Martin Rogers/

/Richard Crispino/  
Supervisory Patent Examiner, Art Unit 1747